

Anthony Court HUGGETT

Appl. No. 10/569,969

November 12, 2010

Response to Non Final Office Action May 12, 2010

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested. To this end, petition is hereby made for a **(3) three-month** extension of time to respond to the outstanding Office Action of **May 12, 2010**.

Claims 20-47 are pending in the application. Upon entry of this Amendment, claims 27 and 36 will be cancelled, claims 20, 23, 28 and 41 – 44 will be amended to clarify the invention, and 21, 22 and 24-26, will be amended to better conform the form of such claims to US claim practice.

In the outstanding Office Action, the Examiner rejected claim 23 under 35 U.S.C. §112, second paragraph, as being indefinite because of the inclusion in this claim of the limitation “substantially but not precisely axially aligned”. Claim 23 has now been amended to change this limitation to -- substantially axially aligned --. In view of this amendment to claim 23, it is believed that the Examiner’s §112 rejection of claim 23 should be withdrawn.

In the outstanding Office Action, the Examiner also rejected claims 20-35, 38, 39 under 35 U.S.C. §102(b) as being anticipated by Eby (USPN 3,405,835), claims 36 and 37 under 35 U.S.C. §103(a) as being unpatentable over Eby in view of Palley (USPN 7,185,778), and claim 40 under §103(a) as being unpatentable over Eby and that which is “well known in the prior art”. The Examiner’s rejections are respectfully traversed.

For a claimed invention to be anticipated by a cited reference, the reference must disclose every element of the claimed invention. For a claimed invention to be obvious over a combination of references, there must have been some reason as to why one of ordinary skill in the relevant art would have combined the references to produce the claimed invention. Here, the

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claims of the present application is not anticipated by Eby because not all of the limitations of the claims are disclosed in Eby. In addition, the claims of the present application are not obvious over the combination of Eby and Palley because, even assuming, *arguendo*, that the Examiner properly combined these references, the result would still not be the claimed invention.

Independent claim 20 of the present application has been amended to recite, *inter alia*, that the collapsible container has a plurality of upper panels and a bottom panel, that each of the panels has a body and an elongate tubular member along all edges of the body, and that the bottom panel of the collapsible container has a plurality of reinforced downwardly protruding supports secured to the bottom panel for raising up the collapsible container.

Applicant contends that neither Eby nor Palley alone or in combination discloses or suggest a bottom panel with a tubular member on all edges of the panel and with downwardly protruding supports secured to the bottom panel for raising up the collapsible container.

Applicant notes that although Palley discloses a panel having tubular members on all edges of the panels (*see* Figure 12 of Palley), it does not disclose a bottom panel with supports secured to the bottom panel for raising up the collapsible container.

With regard specifically to the Examiner's §103(a) rejection of claim 40, which recites that the body and tubular members of a panel are made from cardboard, the Examiner recognizes that Eby does not disclose making the panel body and tubular members from cardboard, but argues that:

It is well known in the prior art to use cardboard to make container in the same field of endeavor for the purpose of preserving quality, cost reduction, lighter in weight.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use cardboard to make the container in order to save money.

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It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. . . .

5/12/10 Office Action, pp. 5 – 6, para. 26 (Citations omitted).

Applicant contends that, while there may be reasons that would lead one of ordinary skill in the art change the material used in Eby or Palley, it would not have been obvious to modify the container to use cardboard, since cardboard is inherently weaker than the materials used in Eby and Palley. Thus, Applicant also contends that the claimed collapsible container's use of cardboard would not amount merely selecting a known material on the basis of its suitability, and moreover, that this clearly shows the inventiveness of attaching supports to the bottom panel.

In addition, it is noted that it is not appropriate for an examiner to use his or her own understanding or experience of what would be basic knowledge when making factual findings for a patentability determination of a claimed invention under §103(a). Rather, the Federal Circuit has said that an examiner must rely on “concrete factual evidence” to support a rejection of the claimed invention. *See In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001). The *Zurko* decision requires an Examiner to provide concrete factual evidence to support his or her determination that claims are not patentable because they are obvious over the cited prior art. *Zurko*, 258 F.3d at 1385-86. (Emphasis added). The same is true with respect to the Examiner's rejection of claim 40 under §103(a) as being obvious over Eby . Thus, it is not proper for the Examiner to rely on assertions of structural features that are “well known in the art” to support his §103(a) rejection of such claims.

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In view of the forgoing, it is believed that this application is now in condition for allowance. If any issues remain with regard to the Election/Requirement, the Examiner is urged to contact the undersigned at the telephone number listed below.

Although the extension fee is being submitted with this Amendment via EFS, the Commissioner is nevertheless hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1140.

Respectfully submitted,

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